

JCWSCS 12 DEC 2003

12/11/03 15:48 FAX 504 734 5233 LAITRAM, L.L.C.

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LEGAL DEPARTMENT

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FACSIMILE COVER SHEET

DATE: December 11, 2003 TIME:

TO: USPTO OIPE YOUR REF: 10/604,033

FROM: James T. Cronvich OUR REF: 2173.1

BY: James T. Cronvich FAX: 703-746-9195

TOTAL # OF PAGES (INCLUDING THIS PAGE) : 10

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MESSAGE:

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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on December 11, 2003.


James T. Cronvich Reg. 33163

Contents:

- Response to Notice regarding Benefit/Priority Claim (3 pages)
- Copy of Application Data Sheet (3 pages)
- Copy of Notice Regarding Benefit/Priority Claim (3 pages)

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Space-Saving Stairs *Precision-Machined Components*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Mark B. Costanzo

Docket No.: 2173.1

Serial No.: 10/604,033

Examiner:

Filed: 06/23/2003

Group Art Unit:

FOR: TILT CONVEYOR

RESPONSE TO NOTICE REGARDING BENEFIT/PRIORITY CLAIM(S)

Commissioner for Patents
P.O. Box 1450
Arlington, VA 22313-1450

Dear Sir:

Applicant requests that the filing receipt of this Application be corrected to indicate that it is a national stage application of PCT/US02/01144, filed 01/09/2002.

On June 23, 2003, applicant's undersigned attorney filed this application electronically through the USPTO's ePAVE system. In filing the application, the attorney's intent was to file a national stage application under 35 U.S.C. §371. The attorney was also trying to use the electronic filing system as the USPTO encourages filers to use. The attorney was attempting to file US Serial No. 10/604,033 as a US national stage application of International Application No. PCT/US02/01144, filed 01/09/2002. This International application, in turn, claimed the priority of earlier filed US Provisional Application No. 60/260,620, filed 01/09/2001. The attorney attempted to make this clear in the Continuity Data Section of the ePAVE filing system. The Application Data Sheet generated by ePAVE and attached for your reference clearly indicates:

"This is a National Stage of GC application number PCT/US02/01144, filed 2002-10-09."

s:\2173.1\RESP NTC RE BENEF-PRI CLMS.doc

On Nov. 7, 2003, the OIPE mailed the Filing Receipt of Serial No. 10/604,033 to applicant's attorney. The filing receipt was accompanied by the attached Notice Regarding Benefit/Priority Claim(s). The Notice indicated that the "Prior-Filed Nonprovisional Application has been Improperly Indicated as a National Stage (35 U.S.C. §371) Application." Furthermore, the form paragraph reads: "Applicant submitted a benefit claim to a prior-filed nonprovisional application and improperly indicated that the prior filed application is a national stage application under 35 U.S.C. §371. The office's records show that the prior-filed application is an application filed under 35 U.S.C. §111(a)."

Applicant contends that:

1. The statement in the form does not apply to this filing because applicant did not indicate that the prior-filed application is a national stage application. The prior-filed application is not a national stage application. The prior-filed application is not a national stage application, but an International Application (PCT/US02/01144), not an application filed under 35 U.S.C. §111(a), as indicated in the Notice.
2. It is clear on the face of the attached electronically-generated Application Data Sheet that applicant intended this to be a national stage application under 35 U.S.C. §371 entitled to the International filing date of 01/09/2002 and to the priority date of 01/09/2001 (Provisional Application No. 60/260,620).

Applicant requests the OIPE to correct the filing receipt to indicate this priority claim.

If there is a better way to have this filing corrected or if it would facilitate matters to discuss this with the undersigned by phone, please call him at 504-733-6739, ext. 1243.

Respectfully submitted,
Mark B. Costanzo

Date: Dec. 11, 2003

By:

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| APPLICATION NUMBER | FILING OR 371 (C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|--------------------|------------------------|-----------------------|------------------------|
| 10/604,033 | 06/23/2003 | Mark B. Costanzo | 2173.1 |

CONFIRMATION NO. 1032

OC000000010926501

09748
 LAITRAM, L.L.C.
 LEGAL DEPARTMENT
 220 LAITRAM LANE
 HARAHAN, LA 70123

Date Mailed: 11/07/2003

Notice Regarding Benefit/Priority Claim(s)

Improper Benefit Claim(s) to Prior-Filed Nonprovisional Application(s)

The benefit claim(s) to prior-filed nonprovisional application(s) is improper because there is no specific reference for each prior-filed application that includes: (1) the identification of the prior-filed application by application number, or international application number and international filing date; and (2) a clear indication the relationship (i.e., continuation, divisional, or continuation-in-part) of the nonprovisional applications. For example, applicant should amend the specification to include a specific reference, such as "This application is a continuation of Application No. 10/---,--- filed ---" in the first sentence of the specification following the title.

Applicant should review each benefit claim submitted and, if appropriate, provide the proper reference to the prior-filed application(s) as required by 37 CFR 1.78. A proper relationship includes an identification of each nonprovisional application as a continuation, divisional or continuation-in-part application of the immediate prior-filed nonprovisional application for which a benefit is claimed under 37 CFR 1.78 in order to establish copendency throughout the entire chain of prior-filed applications. The specific reference must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

Timeliness: The required reference for each benefit claim must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed. See 37 CFR 1.78(a).

Improper Benefit Claim(s) to Prior-Filed Nonprovisional Application(s)

The benefit claim(s) to prior-filed provisional application(s) is improper because the instant application was not filed within twelve (12) months from the filing date of the provisional application,

and there is no indication of an intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed within 12 months of the filing date of the provisional application. For example, applicant should amend the specification to include a specific reference, such as "This application is a continuation of Application No. 10/---,--- filed ---, which claims the benefit of U.S. Provisional Application No. 60/---,--- filed---." in the first sentence of the specification following the title.

Applicant should review each benefit claim submitted and, if appropriate, provide the proper reference to the prior-filed applications (including an indication of any intermediate nonprovisional application that is directly claiming the benefit of the provisional application and filed within 12 months of the filing date of the provisional application) as required by 37 CFR 1.78. The required reference must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

Timeliness: The required reference for each benefit claim must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed during the pendency of the instant application.

Improper Priority Claim(s) to Prior-Filed Foreign Application(s)

The instant application was not filed within twelve (12) months from the filing date of the prior-filed foreign application, and there is no benefit claim to an intermediate nonprovisional application filed within 12 months of the filing date of the foreign application. Applicant should review each priority claim submitted and, if appropriate, provide the proper reference to any intermediate nonprovisional application filed within 12 months of the filing date of the foreign application in compliance with 37 CFR 1.78, or delete the priority claim. The required reference to an intermediate nonprovisional application must be included in the domestic priority information section of an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title.

Timeliness: The required reference for the benefit claim to an intermediate nonprovisional application must be filed during the pendency of the instant application and within the later of: (1) four months from the actual filing date of the instant application, or the national stage commencement date if the instant application is a national stage application under 35 U.S.C. 371; or (2) sixteen months from the filing date of the prior-filed application. Failure to timely file the required reference is considered a waiver of any benefit claim, unless a grantable petition to accept an unintentionally delayed claim under 37 CFR 1.78(a), the surcharge set forth in 37 CFR 1.17(t), and the required reference are filed.

Benefit Claims to More Than 400 Prior-Filed Applications

The Office's automated system to record and capture benefit claims is only capable of recording benefit claims for 400 prior-filed applications. Therefore, the Office is unable to generate a filing receipt containing benefit claims for more than 400 prior-filed applications even though applicant is entitled to submit benefit claims for more than 400 prior-filed applications. Accordingly, applicant should not request a corrected filing receipt to include benefit claims for more than 400 prior-filed applications.



Prior-Filed Nonprovisional Application has been Improperly Indicated as a National Stage (35

U.S.C. 371) Application

Applicant submitted a benefit claim to a prior-filed nonprovisional application and improperly indicated that the prior-filed application is a national stage application under 35 U.S.C. 371. The Office's records show that the prior-filed application is an application filed under 35 U.S.C. 111(a). The Office has entered the benefit claim to the prior-filed application as a benefit claim to an application filed under 35 U.S.C. 111(a). Any request for a corrected filing receipt to include the indication that the prior-filed application is a national stage application will not be granted unless applicant supplies evidence that the prior application was in fact a national stage application. Accordingly, applicant should not submit such request without such evidence. Applicant should submit an amendment (or an application data sheet (ADS) if the benefit claim was submitted in an ADS) to delete the indication that the prior-filed application is a national stage application.

For more information and examples on benefit claims, please see Claiming the Benefit of a Prior-Filed Application under 35 U.S.C. 119(e), 120, 121, and 365(g), 1268 Off. Gaz. Pat. Office 89 (March 18, 2003), which is available on the USPTO website at <http://www.uspto.gov/web/offices/com/sol/og/2003/wcck11/patbcne.htm>, and the Manual of Patent Examining Procedure (MPEP) §§ 201.11 and 201.14.

PART 2 - COPY TO BE RETURNED WITH RESPONSE